

## II. REMARKS

Claims 1, 2, 4 to 7, 9 to 13, 15 to 17, 23 and 24 are presently under examination. By this amendment, claims 9 has been amended to correct an improper dependency and therefore place the application in condition for allowance or in better form for consideration on appeal. The amendment was not made earlier as it was Applicant's position that the claims as previously presented set forth patentable subject matter. An issue of new matter is not raised by these amendments and entry thereof is respectfully requested.

In view of the preceding amendments and the remarks which follow, reconsideration and removal of the rejections set forth in the Final Office Action is respectfully requested.

Applicant's undersigned attorney also thanks the Examiner for the courtesy extended to her and Applicant during the November 5, 2003 telephonic interview. The interview was helpful in clarifying the issues under consideration.

### 35 U.S.C. § 112, Second Paragraph

Claims 9 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, as alleged by indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office also noted that claim 9 depends from canceled claim 8.

In response to the Office's rejection, claim 9 has been amended to depend from claim 1, rather than canceled claim 8. This amendment has removed the grounds for rejection, and its withdrawal is therefore respectfully requested.

### 35 U.S.C. § 102

Claims 1, 2, 9-11 and 15-17 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Peyman, U.S. Patent No. 5,964,748. The Office alleged that claim 1 is anticipated by the language of the '748 patent, in particular: column 12, lines 34 to 40; column 13, lines 32 to 35; column 15, lines 58 to 66 and column 17 lines 28 to 31.

The Office also noted the embodiment depicted in Figure 89 (column 29, lines 45 to 58).

Applicant respectfully traverses. Amended claim 1 and its dependants is directed to a method for correcting defects in vision by cutting a small incision in the anterior surface of the cornea of the eye, creating a circular intracorneal channel originating at said incision and widening the channel to create a widened channel and inserting an intracorneal implant into the widened channel through said incision. The '748 patent fails to teach or enable this method because it fails to describe a method that utilizes a widened, circular intracorneal channel originating at said incision to insert an intracorneal implant into the channel. The Office alleges that the circular channel shown in Peyman is widened in certain locations to accommodate a ring of non-uniform cross-section citing column 18, lines 4-11; column 13, lines 30-39; column 3, lines 58-61; column 17, lines 28-31; column 21, lines 46-49, and the intracorneal implant 430 is introduced into the widened channel through the small incision 418 (column 16, lines 63-67). The Office also directed Applicant to Figure 89 (column 29, lines 45-58), wherein a relatively small arcuate slit 1118"" is formed in the exterior surface of the cornea 1112, a circular intracorneal channel 1120"" is created, the circular channel is widened (column 29, lines 54-55), and "an ocular implant can be inserted into the annular pocket" (column 29, lines 56-57).

Column 12, lines 31 to 39 describes the creation of an incision into the cornea into which a laser or spatula is inserted to create an intrastromal or internal pocket (column 12, line 44). Column 12, line 40 through column 13, line 39 further describes the formation of a pocket. Column 15, line 30 to column 18, line 14 (Figures 37 to 45) also describe a method wherein a pocket is formed from the initial incision but further includes removal of corneal tissue. The embodiment of Figures 46 to 53 (described in column 18, line 15 through column 19, line 46) the inserts are "radially directed" (column 18, line 25) with a flat pin, laser or blade spatula. Opaque portions of the eye are also removed (column 18, line 18). Figure 89 illustrates an embodiment wherein the cornea is dissected to form a small corneal flap (column 29, lines 45 to 49).

With respect to amended claims 12, 13, 24 and their dependents, the '748 patent fails to teach, suggest or enable the claims because fails to enable or teach the use of widening said circular intracorneal channel by inserting a clockwise pocket-forming dissector blade having a side-leg through said incision (see claims 12 and 13). The '748

patent also does not teach or enable the use of an arc-shaped tube to insert a continuous ring implant into the pocket (claims 23 and 24).

Thus, upon reading the cited portions of the patent in their proper context, it is clear that the '748 patent does not teach or suggest the invention of claims 1 and 24 and their dependents. Reconsideration and removal of the rejections is respectfully requested.

### 35 U.S.C. § 103

Claims 6, 8 to 11, 13, 23 and 24 stand rejected under 35 U.S.C. § 103 as allegedly obvious over the '748 patent. Claims 4, 5, 7 and 12 stand rejected as allegedly obvious over the '748 patent in view of Mathis et al., U.S. Patent No. 5,846,256 (the '256 patent). Applicant respectfully traverses. The '256 patent was cited for teaching the employment of clockwise and counter-clockwise dissectors and channel connectors. Applicant respectfully traverses.

The Applicant's remarks have been reviewed. The Applicant asserts that Peyman "fails to describe a method that utilizes a widened, circular intracorneal channel originating at said incision to insert an intracorneal implant into the channel" (Paper No. 28: page 4, lines 23-25). The term "incision" is defined as "a division of the soft parts made with a knife" (Stedman's Medical Dictionary, 26<sup>th</sup> edition, 1995). In the embodiment of Figures 37-45 of Peyman, the circular channel originates at one end or side of the division or incision 418. Although the figures depict an oblique incision, the Applicant's own invention likewise encompasses such, as seen from page 13, line 13, through page 14, line 11, for example. The Applicant apparently specifically alleges that Peyman "fails to teach or suggest the creation of a circular intracorneal channel" (Paper No. 28: page 5, lines 24-26). The examiner disagrees: a circular channel is evident from Figures 43-45 and from column 17, lines 26-28, for example.

Applicant re-asserts and incorporates by reference the remarks in response to the rejections under 35 U.S.C. § 102. The rejected claims are not taught or suggested by the '478 patent because the patent fails to teach or suggest the creation of a circular intracorneal channel. The patent discloses the creation of multiple radial channels or a pocket using Applicant's claimed pocket-forming dissecting blade having a side leg. The rejections are in error and Applicant respectfully requests their removal.

### III. CONCLUSION

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or credit any overpayment to Deposit Account No. 50-2518, referencing billing no.: 2023915-7004262001. If a telephone interview would advance the prosecution of this application, the Examiner is invited to telephone the undersigned attorney at the number provided below.

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